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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,616	12/07/2000	Jeffry Grainger	20313-000500US	4192

EXAMINER	
MOONEYHAM, JANICE A	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/733,616	GRAINGER, JEFFRY	
	Examiner	Art Unit	
	Jan Mooneyham	3629	MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 December 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the communication filed on December 7, 2000.

Claims 1-33 are currently pending in this application.

Information Disclosure Statement

The information disclosure statements filed on The information disclosure statement (IDS) submitted on May 2, 2002, March 7, 2003, and April 9, 2003 are being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant states that a "signal" is received. What type signal?

Applicant needs to identify the abbreviation IDS.

What does the applicant mean by "automatically"?

What is "a field in a mouse pop-up window"?

What is applicant trying to identify in the term "electronic button"?

3. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps or elements, such omission amounting to a gap between the steps or structure. See MPEP § 2172.01. The omitted steps or elements are:

Applicant claims to be associating the IDS information with an electronic information disclosure statement. What does applicant mean? How is the associating done?

What does the applicant mean by "extracting the IDS information."

What is a "pointer," and what does the applicant mean that each pointer corresponds to an electronic document?

How is the IDS information extracted using a pop-up menu?

How do the computer instructions provide a prompt to a user for generating a signal?

How do the instructions save the electronic information disclosure statement?

How do the instructions provide access to the IDS to multiple users?

What information is extracted and from what reference information?

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to

pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-23 only recite an abstract idea. The recited steps of receiving a signal and associating information does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea. There is no technology recited in the body of the claims.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "computerized". Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention generates an information disclosure statement (i.e., repeatable, useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-33 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 5, 6, 8-14, 21-25, 27, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunter et. al (US Patent 6,298,327) (hereinafter referred to as Hunter).

Referring to Claims 1 and 24:

Hunter discloses computer implemented method and system for generating an information disclosure statement comprising:

receiving a signal indicating that a user has identified an electronic document that contains reference information to be disclosed to a patent office, the reference information including IDS information (col. 3, lines 53-66, col. 17, lines 3-7); and

Associating the IDS information with an electronic information disclosure statement (col. 3, lines 53-66, col. 17, lines 3-7).

Referring to Claims 2 and 25:

Hunter further discloses a method wherein associating includes storing the IDS information in the electronic information disclosure statement (col. 17, lines 3-7, Figs. 1-3).

Referring to Claims 5 and 27:

Hunter further discloses a method further comprising extracting IDS information from the reference information (col. 17, lines 3-7).

Referring to Claim 6:

Hunter further discloses a method wherein the IDS information is extracted from the reference information automatically in response to the signal (col. 17, lines 3-7).

Referring to Claim 8:

Hunter further discloses a method wherein the prompt comprises a field in a mouse pop-up window (col. 5, lines 54-63).

Referring to Claims 9 and 10:

Hunter further discloses a method wherein the prompt comprises an electronic button or a computer screen icon (Fig. 8 (155), Fig. 5).

Referring to Claim 11:

Hunter further discloses a method wherein the electronic document is downloaded from a database coupled to a computer network (Fig. 1).

Referring to Claim 12:

Hunter further discloses a method comprising saving the electronic information disclosure statement in a database (Fig. 2).

Referring to Claim 13:

Hunter further discloses a method wherein the database is a local database coupled to a local computer network (Figs. 1-3).

Referring to Claim 14:

Hunter further discloses a method wherein the database is a remote database coupled to the internet (Fig. 1).

Referring to Claims 21 and 22:

Hunter discloses a method where the electronic document is an electronic version of a US patent or wherein the document is an electronic version of a foreign patent document (col. 5, lines 9-11).

Referring to Claim 23:

Hunter discloses a method wherein the electronic document is an electronic version of a publication (col. 5, line 11).

Referring to Claim 32:

Hunter further discloses a computer system wherein the computer-readable memory further includes computer instructions to save the electronic information disclosure statement in a database (Figs. 1-4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4, 15, 17-20, and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter as applied to Claims 1 and 24 and further in view of Takano et al. (US 6,434,580) (hereinafter referred to as Takano).

Referring to Claim 4:

Hunter discloses the limitations of Claim 3. Hunter does not disclose a method wherein receiving a second signal indicating that a patent application corresponding to the electronic information disclosure statement is being electronically filed in a patent office; Transmitting the IDS information from each electronic document corresponding to the plurality of pointers to the patent office.

However, Takano discloses disclose a method wherein receiving a second signal indicating that a patent application corresponding to the electronic information disclosure statement is being electronically filed in a patent office and transmitting the IDS information from each electronic document corresponding to the plurality of pointers to the patent office (Figs. 15 and 18).

It would have been obvious to one of ordinary skill in the art to incorporate into the method of Hunter the teachings of Takano since the filing patents electronically is an ordinary practice in the industry.

Referring to Claim 15 and 33:

Takano further discloses a method and system comprising providing access to the electronic information disclosure statement to multiple users over a network (Figs. 1-18).

Referring to Claim 17:

Takano further discloses method comprising providing the user with instructions on when an electronic document is to be discloses to a patent office (Figs. 1-18).

Referring to Claim 18:

Takano further discloses a method comprising electronically transmitting the electronic information disclosure statement to a patent office (Figs. 1-18).

Referring to Claim 19:

Takano further discloses a method comprising receiving a second signal indicating that a patent application corresponding to the electronic information disclosure statement is being electronically filed in a patent office; and electronically transmitting the electronic information disclosure statement to the patent office contemporaneously with the patent application (Figs. 15 and 18).

Referring to Claim 20:

Takano further discloses a method comprising automatically generating a letter when the electronic information disclosure statement is filed in a patent office (Figs. 15 and 18- proof transmitting means)

The fact that the letter is to a party in a foreign country or the contents of the letter is non-functional descriptive material and carries little patentable weight.

Referring to Claim 30:

Hunter further discloses a computer system wherein the IDS information is extracted using a pop-up menu system (col. 5, lines 54-63).

7. Claims 7,16, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter as applied to claims 1 and 24 and further in view of Tran (2001/0049707) (hereinafter referred to as Tran.

Referring to Claim 7 and 31:

Tran discloses method and system comprising providing a prompt to the user for generating the signal (page 4, [0041]).

Referring to Claims 16 and 33:

Tran discloses a method and system further comprising prompting the user for an access code when the user requests access to the statement (page 2 [0019]).

8. Claims 3 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter as applied to Claims 1 and 24 and further in view of Porcari (US 2001/0037460) (hereinafter referred to as Porcari).

Referring to Claims 3 and 26:

Porcari discloses associating includes storing a plurality of pointers in the electronic information disclosure statement, wherein each pointer corresponds to an electronic document (Fig. 4 and 5, page 5 [0056])..

9. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter

Referring to Claims 28 and 29:

Hunter does not disclose system wherein the IDS information is extracted with one mouse-click, wherein the IDS information is extracted automatically by parsing the reference information.

However, the Examiner takes Official Notice that it is old and well known to extract information with one mouse click and it is old and well known to extract information by parsing

information. Therefore, it would have been obvious to one of ordinary skill in the art to incorporate these into the disclosure of Hunter since it would have been within the knowledge of one of ordinary skill in the art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eisenberg, Howard discloses that Rule 56 requires the submission of known relevant prior art to the PTO which is done through an IDS.

Eastman Chemical discloses a computer- based system for managing documents.

.Snyder discloses a docketing system for recording, tracking and reporting deadlines associated with IP cases.

Kerven et al discloses a system and method for automatically searching and analyzing IP related documents.

Simpson et al discloses a computerized docketing system for in the field of IP with due day alerts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

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